In the Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-502

EDWARD S. IRONS, PETITIONER

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-10a) and its decision denying reargument (Pet. App. 11a-14a) are not reported. The order of the district court (Pet. App. 14a-17a) is not reported.

JURISDICTION

The judgment of the court of appeals was entered on June 15, 1972. An order denying petitioner's timely motion for reargument was entered on August 21, 1972. The petition for a writ of certiorari was filed on September 27, 1972. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

488-923—72——1

QUESTION PRESENTED

Whether a request for "all unpublished manuscript opinions" of the United States Patent Office is a request for "identifiable records" within the meaning of the Freedom of Information Act (5 U.S.C. 552).

STATUTE INVOLVED

The relevant provisions of the Freedom of Information Act (5 U.S.C. 552) are set forth at Pet. App. 17a–20a.

STATEMENT

This action arose from a request by petitioner, pursuant to the Freedom of Information Act, 5 U.S.C. 552, to inspect "all unpublished manuscript decisions of the Patent Office together with such indices as are available."[1] The Patent Office denied the request on the grounds that the records could not be identified and that disclosure was barred under 35 U.S.C. 122.

Petitioner thereupon brought suit in the United States District Court for the District of Columbia seeking to compel the Patent Office to produce the documents and to maintain and make available for public inspection and copying a current index of manuscript decisions. The action was brought under the Freedom of Information Act which, in pertinent part, requires that "[e]ach agency, in accordance with published rules, shall make available for public inspection and copying—(A) final opinions, including concurring and dissenting opinions, as well as orders,

[1] Manuscript decisions are unpublished typewritten decisions of the Patent Office.

made in the adjudication of cases" (5 U.S.C. 552(a)(2)(A)). The statute also requires that the agency "shall make available for public inspection and copying a current index providing identifying information for the public as to any matter issued, adopted or promulgated after July 4, 1967 * * *" (5 U.S.C. 552(a)(2)(c)).

Where final opinions are not made available and an index is not prepared, the statute provides that the opinion may not be "relied on, used, or cited as precedent by an agency" (5 U.S.C. 552(a)(2)(c)). Pursuant to 5 U.S.C. 552(a)(3) an action may be brought to obtain "identifiable records" of an agency.

The district court ordered the Patent Office to "make available for public inspection and copying a current index providing identifying information for the public as to the unpublished manuscript decisions of the Patent Office since July 4, 1967 * * *" (Pet. 16a). The district court, however, held (Pet. App. 15a) that petitioner's request "'for all unpublished manuscript decisions'" was:

> not a reasonable request for identifiable records, but rather a broad, sweeping, indiscriminate request for production lacking any specificity. "All decisions" is not a reasonably identifiable description, any more than asking for all the books in a particular library or all of the unpublished opinions of the United States District Court. The plaintiff has not shown that he has been denied any reasonable request for specific materials—but only a general request for all opinions, some of which may be excludable as trade secret and some of which may not be. It may be true that some of these opinions

> could be made available under the provisions of the Act if a specific request for an identifiable opinion were made, but a request for all is not specific enough to decide if any particular decision or decisions can be made available.

The district court further noted (Pet. 16a):

> The papers presented indicate that it is arguable that some of the requested materials contain trade secrets excludable under 5 U.S.C. § 552 (b)(4) or 35 U.S.C. § 122. This Court is not required to examine every manuscript decision of the past 100 or more years to decide in each case if there is trade secret or other material which should be excluded. The legislative history of the Act indicates that it was not the intent of Congress to add materially to the burden of overworked courts. (See 1966 U.S. Code Cong. and Adm. News., pp. 2418–19.)

Petitioner appealed from the dismissal of so much of his complaint as requested "all unpublished manuscript decisions" ever rendered by the Patent Office. The court of appeals affirmed.[2] It agreed with the district court that petitioner's request for all unpublished decisions was "too broad" and observed in its opinion denying reargument that (Pet. App. 12a):

[2] The court of appeals noted that there were 175 bound volumes containing manuscript decisions from 1853 to 1954. It remanded to the district court for consideration of petitioner's request for disclosure of indices to these opinions and for any other indices which may be available (Pet. App. 9a–10a, 13a). The court of appeals further noted that it was leaving open the question "whether the remand for consideration of the request for indices might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion should motion to that end be made" (Pet. App. 10a).

> The District Court did not hold, nor do we, that the manuscript decisions of the Patent Office are exempt, as such, from disclosure. But when a request for them is made in such general terms as here, involving a large and indefinite number of records which have accumulated over the entire history of this agency, the agency and the court are entitled to scrutinize the request more carefully for compliance with the Act than in the usual case, illustrated by those which have heretofore been decided by the courts.

ARGUMENT

1. Petitioner claims that the court of appeals, although not in terms relying on " 'equitable discretion,' " nonetheless applied that concept in denying relief (Pet. 15). In actuality, however, the court did not apply the equitable discretion doctrine, because it found that petitioner's demand for "all unpublished manuscript decisions" was neither a request for final opinions or orders under 5 U.S.C. 552(a)(2) nor a request for identifiable records under 5 U.S.C. 552(a)(3) (Pet. App. 12a). As the court pointed out (Pet. App. 4a, 13a), a request for "all" such unpublished manuscript opinions involves "a large and indefinite number of records which have accumulated over the entire history of the agency * * *" (Pet. App. 12a). The question whether the courts may decline as a matter of equitable discretion to compel production of

documents sought under the Act is therefore not in issue in the present case.[3]

2. Petitioner also attacks the court's holding that a request for "all unpublished manuscript decisions of the Patent Office" was so broad that it was not a request for identifiable records under 5 U.S.C. 552 (a)(3) (Pet. 8–9). As the court noted, however, the Act contemplates that a demand for records be reasonably specific. There is a tremendous number of manuscript decisions in the Patent Office, all of which petitioner is seeking,[4] and the courts below properly rejected this sweeping demand as lacking in specificity.[5]

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[3] Indeed, the District of Columbia Circuit has rejected, not adopted, the view ascribed to it by petitioner that nondisclosure of specific documents may be justified on equitable grounds despite the fact that they fall within none of the Act's specific exemptions. See *Getman* v. *National Labor Relations Board*, 450 F. 2d 670. Professor Davis has persuasively argued to the contrary. See Davis, *Administrative Law Treatise* 123–24 (1970 Supp.).

[4] Petitioner alleges that the court of appeals erroneously relied on a disputed affidavit in determining that there is a great number of such decisions. Petitioner's counsel herself admitted, however, that she sought access to "a very large number" of documents (Pet. App. 5a). Moreover, the affidavit was not contradicted insofar as it stated that manuscript decisions may exist in millions of files.

[5] Contrary to petitioner's suggestion, there is no conflict among the courts of appeals. *Wellford* v. *Hardin*, 315 F. Supp. 175, 177 (D. Md.), affirmed on other grounds, 444 F. 2d 21 (C.A. 4) (Pet. 18), was a district court decision that a request made for documents containing certain *specified* information was a request for "identifiable records" within the meaning of 5 U.S.C. 552; since the court of appeals did not decide the issue, there is no conflict in circuits. The other case which is allegedly in conflict, *Wellford* v. *Hardin* (II), 315 F. Supp. 768, is only a district court decision; it held that where the

Petitioner contends, however, that since the Patent Office does not have an index of unpublished decisions, he could not identify the documents more specifically. Congress in the Act required agencies to maintain an index of unpublished decisions beginning in 1967, when the Act became effective, and the district court here required the Patent Office to prepare such an index of its unpublished decisions. But Congress declined to require agencies to assume the burden and expense of "identifying" decisions rendered prior to that date. As the House Committee Report (No. 1497, 89th Cong., 2d Sess., p. 8) stated:

> Subsection (b) would help bring order out of the confusion of agency orders, opinions, policy statements, interpretations, manuals, and instructions by requiring each agency to maintain for public inspection an index of all the documents having precedential significance which would be made available or published under the law. The indexing requirement will prevent a citizen from losing a controversy with an agency because of some obscure or hidden order or opinion which the agency knows about but which has been unavailable to the citizen simply because he had no way to discover it. However, considerations of time and expense caused this indexing requirement to be made prospective in application only. * * * As an incentive to establish an effective indexing system, subsection (b) of S. 1160 includes a

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means for identifying records are exclusively within the control of the agency possessing the records, the agency may not deny a request on the ground that the records have not been identified.

> provision that no agency action may be relied upon, used, or cited as a precedent against a private party unless it is indexed or unless the private party has adequate notice of the terms of the agency order.

Congress thus provided a remedy as to pre-1967 opinions, which are not identifiable due to the absence of indices, by precluding the agency from relying upon them. Since the purpose of disclosure of opinions was to make available administrative materials having "the force and effect of law" (H.Rep. No. 1497, *supra*, at p. 7, the remedy provided for the agency's failure to index and identify obviates any prejudice to a litigant before the Patent Office resulting from non-disclosure of material involved in his case. The Freedom of Information Act, however, neither requires the agency to prepare indices of pre-1967 decisions[6] nor justifies the wholesale disclosure of unindexed decisions that petitioner seeks.

3. Petitioner's final contention (Pet. 20) that the court of appeals should have considered whether he was entitled to partial relief, overlooks the fact that the court of appeals remanded so that the district court could further consider this possibility (Pet. App. 10a, 13a).

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[6] It is uncertain what use petitioner would make of hundreds of thousands of manuscript opinions if they were made available to him without an index.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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